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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,746

09/22/2006

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HAM 830025

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11/13/2009

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

11/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,746	<b>Applicant(s)</b> PATEL ET AL.	
	<b>Examiner</b> Cynthia Hamilton	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009 and others.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/04/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

1. The information disclosure statement filed 04 September 2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited **foreign patent document**; each **non-patent literature publication or that portion which caused it to be listed**; and all other information or that portion which caused it to be listed. Those references for which no copy was filed were crossed out for being non compliant. Filing of English equivalent of a cited foreign patent is not enough to meet the requirement of a legible copy of the cited foreign patent document nor is citation of a weblink sufficient to meet the requirement of a legible copy.

2. The information disclosure statement filed on 04 September 2007 does not fully comply with the requirements of 37 CFR 1.98(b) because: See the paragraph above. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b).** Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the noncomplying information **not** being considered with respect to those references not supplied. See 37 CFR 1.97(i).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinmann et al (DE 44 40 819 A1) as evidenced by machine translation of DE 44 40 819 A1. With respect to instant claims 7-12, Steinmann et al teach compositions which overlap that of instant claims 7-12 wherein the subgenus of acrylate and thiol compositions overlapping at 80% of acrylate and 10 -15% of thiol is disclosed. Steinmann et al fails to teach the speed at which the acrylates cure with all photoinitiators but such is an inherent property of the acrylate and the photocuring initiator combination and since acrylates of the same general nature are pointed to by applicants as having the required cure properties on pages 17-19 the acrylates of Steinmann et al are held to inherently have the property of curability in the instant range with some photocuring initiator in the ultraviolet range. Thus, with respect to instant claims 7-12, wherein the ranges of acrylate and thiol combined along with other acrylates fillers, stabilizers, etc, combined in Steinmann et al which overlap that of the instant compositions to form the molding composition of Steinmann et al would have been *prima facie* obvious to reduce curl in stereo lithographically formed objects. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Werthheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 UAPQ2d 1934 (Fed. Cir. 1990). See particularly MPEP 2144.05. In the machine translation of DE 44 40 819 A1, see particularly page 4 of 5, paragraphs 5-8.

5. Applicant's election with traverse of Group II, claims 7-12 in the reply filed on 02 July 2009 is acknowledged. The traversal is on the ground(s) that the amended claims of Group I and Group II have as now amended a special technical feature in common. This is not found persuasive because The examiner notes that the above rejection addresses why this is not so with

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the added addition that the method of Group I is drawn to using non-coherent light while such is not clearly disclosed as being part of the method of Steinmann et al.

The requirement is still deemed proper and is therefore made FINAL.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 7-8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Vanderlinde (US 3445419). With respect to instant claims 7-8 and 12, the composition of Example 1 of Vanderlinde is a species of composition wherein the composition is disclosed inherently UV curable at col. 2, lines 47-53. The examiner holds that with some choice of photocuring initiator in the UV range that the organosiloxane of Vanderlinde inherently has the capability of being curable in the time and with the energy set forth with some photocuring initiator in the art thus anticipates the instant composition. The examiner notes that the composition as claimed is not required to be so curable only that the first component be so curable inherently.

8. Claims 7-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US 5,250,391). With respect to instant claims 7-9 and 11, the compositions of Example 4 of Miller et al anticipate the instant compositions wherein pentaerythritol tetraacrylate is held to inherently be curable in the manner set forth with some photocuring initiator by exposure to UV radiation as set forth on page 18, line 16 of the instant specification.

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Claims 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kjellquist Lindell et al (WO 00/55272). With respect to instant claims 7-9 and 11 Kjellquist Lindell et al teach compositions which overlap the instant compositions in that the thiol compounds are present in 1-20 parts by weight for 100 parts by weight of the acrylate component. The acrylate is inherently able to be cured with some photocuring agent at the speed set forth in the instant invention. The top weight percentage of thiol present in Kjellquist Lindell et al is about 17 % thus making obvious the combining of acrylate and thiol over the entire range set forth by the instant invention of claims 7-9 and 11 *prima facie* obvious to form the compositions of Kjellquist Lindell et al. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Werthheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 UAPQ2d 1934 (Fed. Cir. 1990). See particularly MPEP 2144.05.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cynthia Hamilton/  
Primary Examiner, Art Unit 1795

November 9, 2009